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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,688	03/30/2001	Koji Naito	018987-032	8787

7590 06/27/2006

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EXAMINER

THOMPSON, JAMES A

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/820,688

Applicant(s)

NAITO ET AL.

Examiner

James A. Thompson

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-28.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Response to Arguments

Applicant's arguments filed 17 June 2006 have been fully considered but they are not persuasive.

Regarding page 2, lines 4-17: Examiner has relied more than the portion of Zhao (US Patent 6,243,480 B1) mentioned by Applicant to demonstrate that Zhao teaches embedding updated predetermined information at a location where said predetermined information was originally embedded, as a cursory reading of page 6, lines 25-28 of the previous office action (mailed 17 March 2006) readily reveals. Therein, Examiner specifically wrote, "embedding said updated predetermined information (column 19, lines 26-30 of Zhao) at a location where the said initial predetermined information is originally embedded (figure 6(619); figure 8(619); and column 11, lines 49-53 and lines 58-62 of Zhao)". These portions clearly demonstrate that the information corresponding to the "Active Watermark" (figure 6(619) and figure 8(619) of Zhao) is updated and the updated information embedded at the same location (column 11, lines 49-53 of lines 58-62 of Zhao). The portion mentioned by Applicant (column 19, lines 26-30 of Zhao) simply further describes the updating of information in the Active Watermark. The agent engine mentioned by Applicant is simply one means by which data is retained and used in the updating of the Active Watermark.

Regarding page 2, line 18 to page 3, line 14: Examiner has fully considered Applicant's discussion of the status of the present claims and Applicant's discussion of claim 1.

Regarding page 3, line 15 to page 4, line 22: Firstly, claim 1 does not recite that the location information is extracted and stored. Although the claims are interpreted in light of the specification, limitations from the specification

are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Secondly, it is inherent in the teachings of Zhao that the location information is extracted and stored since the updated information embedded at the same location that the originally embedded information was extracted.

Regarding page 4, line 23 to page 5, line 7: With all respect, Applicant has erred in reading said previous office action, since Applicant appears to address page 6, lines 22-29 of said previous office action, but incorrectly relates the citations given therein. As stated above, Examiner clearly wrote, "embedding said updated predetermined information (column 19, lines 26-30 of Zhao) at a location where the said initial predetermined information is originally embedded (figure 6(619); figure 8(619); and column 11, lines 49-53 and lines 58-62 of Zhao)" [emphasis added]. The fact that Zhao does teach that said updated predetermined information is embedded at a location where the said initial predetermined information is originally embedded has already been addressed in detail above.

Regarding page 5, line 8 to page 8, line 10: Firstly, the fact that Zhao does teach embedding said updated predetermined information at a location where the said initial predetermined information is originally embedded has already been exhaustively addressed above. Secondly, although the active watermarks used in Zhao may be used in the context of a computer system with a network connection, this does not preclude one of ordinary skill in the art at the time of the invention from combining the teachings of Zhao with the system of Ikenoue (US Patent 5,987,127). The test for obviousness is not whether the features of a secondary reference may be bodily incorporated

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into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, presented with the system of Ikenoue and the teachings of Zhao, one of ordinary skill in the art at the time of the invention would have been motivated to combine the teachings of Zhao with respect to embedding said updated predetermined information at a location where the said initial predetermined information is originally embedded with the watermarking system taught by Ikenoue.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Thompson whose telephone number is 571-272-7441. The examiner can normally be reached on 8:30AM-5:00PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James A. Thompson
Examiner
Technology Division 2625



21 June 2006



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